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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/804,299 | 03/19/2004 | Franklin C. Simon | 032693-114 | 7817 |

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| EXAMINER |
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FISHER, MICHAEL J

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,299

Applicant(s)

SIMON ET AL.

Examiner

Michael J Fisher

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

Claims 1-45 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,195,648. This is a double patenting rejection.

Claims 1-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,195,648. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn to a system for disabling a vehicle upon non-receipt of payment and both the patent and the instant application include the following limitations:

Computing a payment due deadline (claim 1 of the instant application and claim 1 of the patent);

Generating a reference code (claim 1 of the instant application and claim 1 of the patent);

Providing a reference code (claim 1 of the instant application and claim 1 of the patent);

Receiving an additional code via a keypad (claim 1 of the instant application and claim 1 of the patent);

Passing the additional code to a comparator (claim 1 of the instant application and claim 1 of the patent);

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Comparing the additional code to a reference code (claim 1 of the instant application and claim 1 of the patent);

Disabling the vehicle if the codes don't match (claim 1 of the instant application and claim 1 of the patent);

Enabling the vehicle if they do match (claim 1 of the instant application and claim 1 of the patent);

Further claims in the instant application either contain the same limitations, such as independent claims 3 and 12, or are obvious variants, such as claim 2 where the payment due deadline is computed using a payment period or a grace period, which are very well known in the art and would have been obvious to use as payment deadlines. For instance, loan companies generally have a due date and a grace period, where you are later than the due date but still not officially considered 'late'.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-28 and 33-36 and 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 5,917,405 to Joao in view of US PAT 6,647,328 to Walker.

As to claims 1,3,12,14,18,19,20,25,27,33,35,40,41 and 45, Joao discloses a method or enabling and disabling a vehicle (title), that generates a reference code (first signal, claim 1), providing the code to a comparator (inherent in that the system is shown as receiving signals for activating, deactivating, enabling and disabling a system and therefore, would need to compare the incoming signal to the stored signals to know which action to take), receiving an additional code via a keypad (975), this would be periodic (it is shown as being entered more than once, this would be 'periodically), comparing the additional code with a reference code, col 46, line 66-col 47, line 7), passing the additional code to the comparator and comparing (inherent in that the additional code can enable the vehicle and would therefore be compared to allowed, enabling signals), disabling the system if the reference code is not received and enabling the vehicle if the signals are not received. Further, the system is shown to include items not dedicated to directly causing a spark (claim 2, electrical system does not directly initiate a spark, a spark plug does.) It would be inherent the process is not done until the system is initialized as initialization is how computers are activated.

Joao does not, however, teach using the system for loan repayment purposes or computing a deadline. Walker teaches a vehicle disabling system (title) that is taught as being useful for "loan companies" (col 59, lines 2-20). Therefore, it would have been obvious to one of ordinary skill in the art to use the modify the system as disclosed by Joao by using it for ensure loan repayment, as taught by Walker, as failure to pay (missing a deadline) for a car is akin to stealing the car (the ostensible purpose of Joao). Further, it would have been obvious to one of ordinary skill in the art to use a payment deadline as this is when the loan company would require payment in accordance with a loan agreement or repossess the vehicle.

As to claims 2,28,36 it is very well known in the art for loan companies to have a so-called 'grace-period' in their loan repayment schedule. Therefore, it would have been obvious to include a "grace period" as this would avoid disabling a vehicle if the check is in the mail.

As to claims 4,6 and 42, it would be inherent that the due date deadline, and related codes, would be computed throughout the life of the loan as loans are very well known to have more than one payment.

As to claim 5, it would be inherent that a set of reference codes are computed as there are different codes necessary, (enable, disable, etc.) and further, it would have been obvious to compute them together as this would make the process shorter.

As to claim 7, it would be inherent that the computer would have to know if a code exists as the computer is comparing them.

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As to claims 8 and 16, a critical system is disabled (claim 1).

As to claims 9 and 17, the vehicle would be partially disabled in some instances (an example of systems or components disabled is fuel system, disabling this would partially disable the vehicle as the electrical system would work and therefore, the radio, lights and other electrical systems would work.

As to claims 10 and 21, it would be inherent that the enabling step releases a disabled system from its disabled state else it would not be enabled if the system had been previously disabled, through an error inputting a code, or after making a late payment that had resulted in a disabled system.

As to claim 11, it would be inherent that an enabling step leaves the systems enabled if the systems had not been previously disabled.

As to claims 13 and 15, the comparator is shown as triggering an event (disable, enable, activate, deactivate), as the system is used for loans it would have been inherent that "periodic" means 'when the payments are due'.

As to claim 23, input into a keypad would be tactile input and it would inherently change it to digital code else the computer could not understand the input.

As to claim 24, the system is shown to include electrical systems (claim 2).

As to claims 26,34 and 43, computers inherently use algorithms in their computation.

As to claim 42 and 45, it would have been obvious to one of ordinary skill in the art to use different codes each time else the user could learn the codes and avoid the system.

As to claim 44, the number of days would be the length of each payment period and the predetermined date would be the beginning of the relationship between the owner of the vehicle and the owner of the system.

Claims 29-32 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Walker as applied to claims 1-28 and 30-45 above, and further in view of US PAT 5,850,599 to Seiderman.

As for claims 29 and 37, Joao in view of Walker disclose a system as discussed. They do not, however, teach an emergency code that could be used to enable a vehicle. Seiderman discloses a system for disabling a system (cell-phone) in event of non-payment (claim 1) that allows a user to input an emergency number and have the system activated (col 1, lines 35-40).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Joao in view of Walker by allowing an emergency number to activate the system as taught by Seiderman as, if the car is disabled in a dangerous place and the person is hurt, the person could sue the loan company.

As to claims 30 and 38, it would have been obvious to one of ordinary skill in the art to limit the number of emergency 're-enables' allowed to discourage mis-use of the emergency number.

As to claims 31 and 39, the system would be temporarily re-enabled (until the next time the code is needed).

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As to claim 32, it would have been obvious to one of ordinary skill in the art to use a payment deadline as this is when the loan company would require payment in accordance with a loan agreement or repossess the vehicle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 703-306-5993. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.


The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael J Fisher



Patent Examiner
GAU 3629

MF 
3/16/05